

therefrom, in view of the Malatesta patent (U.S. 5,398,922) in combination with Dastoli and Thomas.

The Official Action acknowledges that the Dastoli patent does not disclose a system which has a work surface disposed within a sealed area, with air being suctioned downwardly through the work surface. The Official Action asserts that, in view of the teachings of Thomas, it would have been obvious to a person of ordinary skill in the art to provide, in the Dastoli system, a work surface through which air is suctioned downwardly.

Applicant strongly disagrees with the assertions made regarding the alleged obviousness of this modification. A prima facie case of obviousness requires both that the references cited are properly combinable, and that there be motivation somewhere in the prior art to combine the references or to incorporate features found in one of the references into the device disclosed in the other reference. In the present case, the references are not properly combinable, and even if properly combinable, there has been no motivation shown to combine the particular references as was done in making the rejection. The latter point will be addressed first.

The Official Action appears to be contending that motivation exists for providing a work surface like that shown in the Thomas patent in the Dastoli system, in stating that this combination would have been obvious, "since the laminar flow of filtered air is passed from the top to the bottom of the enclosure to sweep off contaminants from the work surface thus providing a safe environment for the user working at the work station." Notably, neither the Dastoli system nor the Thomas device has, as an objective, providing a safe environment for the user working at a work station. Only the device of the present invention has such an objective, however, it is improper to use the applicant's own teachings as one element of the

motivation. Stated another way, if the claimed invention provides a solution to a problem that was not even contemplated by the cited references, the references can not properly be regarded as rendering obvious the claimed invention.

The Dastoli patent, the principal reference cited, has, as its principal objective, maintaining the surfaces of injection molded articles free of contamination. The Thomas patent seeks to achieve a relatively clean environment for a limb of a patient or a laboratory animal undergoing surgery or other medical operation, but is not concerned with keeping a safe environment for the worker.

Beyond that, there is further no motivation to place a work surface, such as that shown in the Thomas patent, in the Dastoli system. The Dastoli system involves an injection molding operation in which the products produced are handled by a rotating indexing head which must move to three different stations in the molding process. (see, Column 5, lines 12-35). As such, the notion of providing a stationary work surface in the Dastoli system would not only be non-obvious, persons of ordinary skill in the art would not see this as conferring any benefit whatsoever in the Dastoli system.

The Thomas patent fails to provide the necessary motivation as well. First, it should be noted that the Thomas device operates with large areas open to the external atmosphere, and uses a positive pressure environment to keep contaminants from entering the partial enclosure. The use of a positive pressure system is directly contrary to the use, in Dastoli, of negative (vacuum) pressures. The work surface shown in Thomas is simply a way to get a portion of the filtered air back to the air inlet, with another portion exiting through the openings under the influence of internal positive pressure relative to the outside environment. As the Dastoli system already performs the function of removing air from the interior without the use of a work

surface through which the air will be withdrawn, and given that the Dastoli system otherwise has no use for a work surface of this type, it can not reasonably be said that the teachings of the Thomas patent provide the necessary motivation for making this combination.

The motivation seems to be coming solely from the Applicant's own invention, wherein the work surface is provided and the air is suctioned therethrough, to remove contaminants from objects placed thereon or nearby, so as to protect workers in the area from being exposed to those contaminants. As noted previously, it is not proper to refer to Applicant's own disclosure to find any motivation for combining the teachings of the prior art.

The Dastoli and Thomas reference should not even be regarded as being combinable in this situation, in the first place. As noted previously, the Dastoli system is completely sealed to the outside atmosphere and operates in a negative pressure regime. In contrast, the Thomas device has large sections that are physically open to the outside environment, and operates to preclude outside contaminants from entering the operating area by maintaining a positive pressure relative to the external atmosphere. The two systems thus operate using fundamentally different concepts, and the person of ordinary skill in the art would not regard these as both being within the body of relevant prior art.

With respect to independent Claim 15, the same shortcomings in the Dastoli and Thomas patents lead to the conclusion that Claim 15 is patentable over the Malatesta patent in combination with Dastoli and Thomas.

Furthermore, there is no motivation to combine the teachings of Dastoli or Thomas with the Malatesta reference.

The rejection has, as its foundation, an alleged motivation to, “provide a safe and dust-free environment for the postal workers to work in”. As Applicant noted in the previous response, filed November 4, 2002, the Malatesta patent discloses an apparatus which is a fully automated feeder system for an automated mail sorter. There are, simply put, no postal workers working in and around this equipment when in normal operation. Thus, how can it be said that it would have been obvious to add equipment such as that disclosed in Dastoli to the Malatesta device? If the alleged motivation for doing so is to provide a safe environment for workers, yet there are no workers normally manning the equipment, the logic employed is seriously flawed.

The January 29 Office Action fails to address this argument, and simply repeats the language from the earlier rejection. In the event that the Examiner carefully considers this argument, yet finds it unpersuasive, Applicant is entitled to a detailed refutation of the argument, which goes to the core of the rejection. The issues will not be properly framed for appeal in the absence of a statement of the Examiner’s position on this issue.

The newly-cited Thomas patent does not make up for the shortcoming in the motivation required to legitimize the grounds of rejection. With the inclusion of the Thomas patent as potentially relevant prior art, the combination used in rejecting Claims 15-37 involves three pieces of equipment, each having a different mode of operation insofar as the atmospheric control is concerned. Malatesta, because workers will not be attending the equipment at work station, does not have, and need not have, any air containment or purification, or the like. Dastoli provides a system operating at a negative (vacuum) pressure. Thomas provides a system operating at a positive pressure. It is significant that none of these has, as an objective, providing a

safe environment for a worker in the area. Applicant fails to understand how it can legitimately be contended that the claimed invention would have been obvious in view of these three references, when none of them are even concerned with addressing the problem solved by the present invention.


Applicant further relies on, and incorporates herein by reference, all of the remarks and arguments presented in the November 4 Amendment, in that those remarks and arguments were largely ignored in the January 29 Office Action.

In view of the foregoing, Applicant believes that all of Claims 1-37 as currently presented are patentable over the cited references to Dastoli, Thomas, and Malatesta, as well as the additional references to Long, Renz, Chormenky, Hofstra, and Kinkead. Reconsideration and withdrawal of all rejections made under 35 USC §103(a) are therefore respectfully requested. Passage of the application to issue at an early date is earnestly solicited.

Respectfully submitted,

MILES & STOCKBRIDGE P.C.

By:

  
John C. Kerins  
Reg. No. 32,421

1751 Pinnacle Drive, Suite 500  
McLean, Virginia 22102-3833  
Telephone: (703) 610-8649  
#9195187v1